REMARKS

The Office Action dated June 24, 2004, has been received and carefully noted. The amendments made herein and the following remarks are submitted as a full and complete response thereto.

By this Amendment, claims 4, 7, 9, 10 and 12 have been amended and new claims 13-15 have been added. Applicant submits that the new claims as well as the amendments made herein are fully supported in the specification and the drawings as originally filed, and therefore no new matter has been added. Accordingly, claims 3-15 are pending in the present application and are respectfully submitted for consideration.

Allowable Subject Matter

Applicant appreciates the indication of allowable subject matter in claims 7 and 10 of the present application.

Claims 3-12 Recite Patentable Subject Matter

Claims 3-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Marbot (U.S. Patent No. 5,268,937) and further in view of Ducaroir et al. (U.S. Patent No. 6,061,747, hereinafter "Ducaroir"). Applicant respectfully traverses this rejection and submits that claims 3-12 recite subject matter that is neither disclosed nor suggested by the cited prior art.

Claim 4 recites a method of transferring an encoded data signal including a clock signal and a data signal comprising, among other features, the step of selecting a read clock signal corresponding to the determined data transfer speed from a plurality of read clock signals, wherein the plurality of read clock signals correspond to a plurality of predetermined data transfer speeds, respectively.

Claim 9 recites an apparatus for transferring an encoded data signal including a clock signal and a data signal comprising, among other features, a transfer speed determining circuit for determining a data transfer speed of the encoded data signal in accordance with the write clock signal, wherein the transfer speed determining circuit selects a read clock signal corresponding to the determined data transfer speed from a plurality of read clock signals, wherein the plurality of read clock signals correspond to a plurality of data transfer speeds, respectively, and the decoded data signal is read from the memory in accordance with the read clock signal.

It is respectfully submitted that the prior art fails to disclose or suggest at least the above-mentioned features of the Applicant's invention.

The Office Action characterized Marbot as allegedly disclosing a "system and method for digital transmission with ... determining a data transfer speed [transmission speed] of the encoded data signal [TS] using the write clock [CL] signal [col. 1, lines 48-56, col. 3, lines 32-38, col. 10, lines 1-33, fig. 5]; generating a read clock signal [CL] having a frequency corresponding to the determined data transfer speed [col. 10, lines 1-33]; reading the decoded data signal [RD] stored in the memory [register] in accordance with the read signal [CL] [col. 11, lines 19-50]."

Ducaroir is applied for allegedly teaching "a system and method encoded data transfer to-and-from with a TX/RX core [510, fig. 7] with encoded data stream incoming to TX/RX and input to receiver [710] to a receive buffer [740] and transferred to decoder [750, deserializer 750] ..."

Applicants submit that neither Marbot nor Ducaroir, taken alone or in combination, disclose or suggest each and every element recited in claims 4 and 9 of

the present application. In particular, it is submitted that the cited prior art fails to disclose or suggest at least the step of selecting a read clock signal corresponding to a determined data transfer speed from a plurality of read clock signals respectively corresponding to a plurality of predetermined data transfer speeds, as recited in claim 4; and at least a transfer speed determining circuit having the above function as recited in claim 9. Therefore, Applicant submits that Marbot and/or Ducaroir fails to disclose each and every element recited in claims 4 and 9 of the present application, and are allowable.

In order to establish a *prima facie* case of obviousness, each feature of a rejected claim must be taught or suggested by the applied art of record. See M.P.E.P. §2143.03 and *In re Royka*, 490 F.2d 981 (CCPA 1974). As explained above, Marbot and Ducaroir, taken alone or in combination, do not teach or suggest each feature recited by claims 4 and 9. Accordingly, for the above provided reasons, Applicants respectfully submit that pending claims 4 and 9 are not rendered obvious under 35 U.S.C. § 103 by the teachings of Marbot and Ducaroir.

As claims 3, 5, 6 and 8 depend from claim 4, and claims 11 and 12 depend from claim 9, Applicant submits that each of these claims incorporates the patentable aspects therein, and are therefore allowable for at least the reasons set forth above with respect to the independent claims, as well as for the additional subject matter recited therein.

As for new claims 13-15, each of the new claims depend from claims 4 and 9, respectively, and are similarly allowable for at least the reasons set forth above with

respect to the independent claims, as well as for the additional subject matter recited therein.

Under U.S. patent practice, the PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002). The Office Action restates the advantages of the present invention to justify the combination of references. There is, however, nothing in the applied references to evidence the desirability of these advantages in the disclosed structure.

As such, Applicants respectfully request withdrawal of the rejection.

Conclusion

In view of the above, Applicant respectfully submits that each of claims 3-15 recites subject matter that is neither disclosed nor suggested in the cited prior art.

Applicant also submits that the subject matter is more than sufficient to render the claims non-obvious to a person of ordinary skill in the art, and therefore respectfully requests that claims 3-15 be found allowable and that this application be passed to issue.

If for any reason, the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact the Applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper has not been timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing docket number 108075-00033.**

Respectfully submitted,

Sam Huang
Attorney for Applicants
Registration No. 48,430

Customer No. 004372
ARENT FOX, PLLC
1050 Connecticut Avenue, N.W., Suite 400
Washington, D.C. 20036-5339
Tel: (202) 857-6000
Fax: (202) 638-4810

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Enclosures: Petition for Extension of Time
RCE Transmittal

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